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REMARKS

Claims 1-4, 6-14, 16-41, and 43-70 remain in the application with claims 1 and 38 in independent form.

Claims 1-4, 6-14, 16-41, and 43-70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tatsuya et al. (JP 2000-271534) as generally recited in the prior Office Action in view of Reh fuss et al. (United States Patent No. 6,117,931) and in further view of Spencer et al. (United States Patent No. 6,242,056), Murayama et al. (United States Patent No. 5,424,006), Schimmel et al. (United States Patent No. 5,585,427), and Zhao et al. (United States Patent No. 6,036,999).

As the Examiner is aware, to appropriately establish a *prima facie* case of obviousness, three basis criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Applicant respectfully asserts that the Examiner has once again not established the requisite *prima facie* case of obviousness and, therefore, traverses this rejection.

On Page 2 of her Office Action, dated April 19, 2005, the Examiner asserts that Reh fuss et al. teaches a curable composition that "may be utilized in a color-plus-clear coat system, particularly as the clearcoat, and comprises at least one effect pigment..." The Applicant respectfully asserts that the Examiner has misinterpreted Reh fuss et al. and that, as a result, the Examiner's assertions are only partially accurate as described below.

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As the Examiner is likely aware, the Applicant is well aware of the disclosure of Rehfuß et al. in large part due to the fact that Rehfuß et al. patent is assigned to BASF Corporation, who is also the Assignee of record in the subject application. While it appears accurate that (1) the curable composition of Rehfuß et al. can be used in a color-plus-clear coat system, particularly as a clearcoat, and while it also appears accurate that (2) the curable composition comprises at least one effect pigment, (1) and (2) taken together are not accurate. That is, there is no disclosure in Rehfuß et al. that actually “puts” the effect pigment (C) in a clearcoat when the curable composition of Rehfuß et al. is used as a clearcoat.

In fact, as described immediately below, when the curable composition is used as the clearcoat, the pigment comes in through a pigmented basecoat composition and not the clearcoat composition. More specifically, referring to Column 12, lines 17-21, “[w]hen the coating composition according to the invention is used as the clearcoat of a composite color-plus-clear coating, the pigmented basecoat composition may [be] any of a number of types well-known in the art.” In other words, in this particular embodiment of Rehfuß et al. where the composition is used as the clearcoat, the pigment comes in via the “pigmented” basecoat composition. Those skilled in the art readily realize that effect pigments, such as metallic pigments, are not incorporated into clearcoats in automotive applications where high gloss and DOI coatings, i.e., aesthetically-pleasing coatings, are desired. The only message that Rehfuß et al. attempts to convey is that its curable coating composition, with the particular carbamate-functional component, i.e., the resin, can be used in a clearcoat application without, of course, the effect pigment.

Furthermore, it can even be argued that Rehfuß et al. actually teaches away from the

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invention claimed in the subject application where a phosphorescent pigment is included in the clearcoat composition such that, upon application and cure, exposure of the phosphorescent pigment to an external energy source is maximized. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984), very clearly holds that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention and Reh fuss very clearly discloses un-pigmented clearcoat compositions/layers in combination with basecoat compositions/layers. Referring to Column 11, lines 51-58, “[w]hen the curable coating compositions of the invention [of Reh fuss et al.] is [sic] used as a basecoat in a composite color-plus-clear coating, the clearcoat may be those such as are known to those skilled in the art.” It is further explained that the preferred clearcoats are clearcoats that comprise a carbamate functional polymer or those disclosed in United States Patent No. 5,474,811 which is incorporated by reference in Reh fuss et al. Notably, the clearcoats disclosed in the ‘811 patent do not include pigments (*see the entire document*). There is even precise support for this position (where un-pigmented clearcoat compositions/layers are used) in the particular examples of Reh fuss et al. More specifically, referring to Columns 13 and 14 and Coatings I and II of “Example 1”, Reh fuss et al. sprays the basecoat (Coatings I and II) to 0.7 mil film build and then, after a 2 minute flash, coats the sprayed panels with a conventional, un-pigmented, i.e., no effect pigment, clearcoat, specifically BASF Corporation’s E126CE012A (*see, in particular, Column 14, lines 28-31*). That is, Coatings I and II, and not the clearcoat, include the effect pigment (C).

It is also notable that there is no luminescent pigment, let alone phosphorescent pigment,

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disclosed in Reh fuss et al. The Examiner has also misinterpreted the disclosure of Reh fuss et al. in the context of the actual pigments that are disclosed. Referring to Column 8, line 58 – Column 9, 48, Reh fuss et al. merely discloses that certain “[i]llustrative effects and/or appearances” can be achieved with the effect pigment (C). Along with “sparkle” and “dazzle”, one of the effects that can be achieved is a “luminescence” effect. To accomplish such effects, Reh fuss et al. discloses a wide array of specific effect pigments (C), particularly metallic pigments and hydrated aluminum silicate (mica) pigments. None of these specific effect pigments (C) are luminescent and/or phosphorescent pigments.

Reh fuss et al. is completely silent with respect to the use of luminescent and, more specifically, phosphorescent pigments. In fact, referring to Column 9, lines 33-48, Reh fuss et al. even includes a long list of “other effect pigments” that can be used in combination with the “at least one effect pigment (C)”. This list includes many different types of pigments. However, luminescent and phosphorescent pigments are notably absent from this list.

In view of the above remarks, it is apparent that no appropriate *prima facie* case of obviousness has been established. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to appropriately combine the teachings of Tatsuya et al. and Reh fuss et al. In fact, as described above, it can even be argued that the Reh fuss et al. teaches away from the claimed invention. Furthermore, in view of the clarification of Reh fuss et al. set forth above, even assuming combination of Tatsuya et al. and Reh fuss et al., all of the elements claimed in independent claims 1 and 38 are not taught or suggested. Importantly, the other prior art references (to Spencer et al., Murayama et al., Schimmel et al., and Zhao et al.) do not remedy these

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deficiencies.

As such, it is respectfully submitted that independent claims 1 and 38 are allowable and the remaining claims depend either directly or indirectly from the non-obvious features of claims 1 and 38 such that the dependent claims are also allowable.

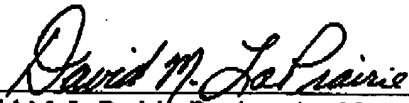
It is respectfully submitted that the Application is now presented in condition for allowance, which allowance is respectfully solicited.

No fees are believed to be due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

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